

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 09/623,575

Applicant: OHMAE et al.

Filed: September 6, 2000

TC/AU: 2623

Examiner: H. Tran

Docket No.: 400830

Customer No.: 23548

APPELLANTS' REPLY BRIEF

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Sir:

Appellants reply to the Examiner's Answer mailed January 24, 2007, as follows.

In commenting on the arguments in favor of the patentability of claim 50, at pages 39 and 40 of the Examiner's Answer, the Examiner pointed out an incorrect characterization of the subject matter of claim 50. Appellants' representative is solely responsible for this error, which is regretted.

Appellants request that the following paragraph be substituted for the two paragraphs concerning claim 50 that appear at pages 19 and 20 of Appellants' Brief.

At page 20 of the final rejection, the Examiner rejected claim 50 by stating that its limitations "are met by that discussed above for claims 29 and 43." To the extent claim 50 stands rejected, Appellants respond not only with the generic distinction presented above as to all claims, but

also the foregoing comments regarding the final rejection of claims 29 and 43. For example, the asserted references do not, for the reasons presented multiple times, describe a system in which attentiveness is measured by supplying, from time-to-time, a viewing confirmation code with a desired response consisting of the identical viewing confirmation code.

In answering Appellants' distinctions between claim 29, perhaps the most general of the independent claims on appeal, and Lemelson, the Examiner alleged that Lemelson was misconstrued and does not teach away from the claimed invention. The Examiner pointed out that in Lemelson the student uses an input device, for example, as shown in Figure 2 of Lemelson, for inputting a selected answer, from a group of proposed answers, in replying to a question. In other words, the question is a multiple choice question. According to the Examiner, when an answer is selected by the student, "the selected answer is identical to one answer of the group of proposed answers," The assertion is not understood because it is not consistent with the claims on appeal. There has been no misconstruction of Lemelson.

Claim 29, like the other independent claims, requires that "the viewing confirmation code to be entered [must be] identical to the viewing confirmation code presented to confirm viewing of the audio-visual program". As pointed out in Appellants' Brief, this means that the viewer's answer must be identical to the question to confirm attentiveness. It is common knowledge that a so-called multiple choice question includes a question followed by several alternative answers to the question. Thus, what is presented to a student comprises both the questions and the multiple alternative answers. When the student using the Lemelson system selects one of the answers, he is sending back to the lecturer an identifier for the selected answer. For example, a question might be presented followed by optional responses (a), (b), and (c). The question must include text presented in some form and each of the alternative answers must likewise include some text. When the student in Lemelson presses one of the buttons to signal a response, it makes sense that only a

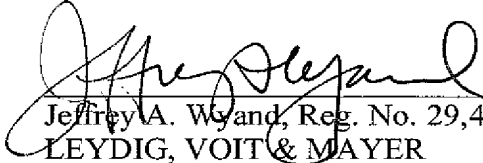
symbol representing one of the selected answers is supplied to minimize the amount of information transmitted. Moreover, even if the student sent back the question and each of the alternative multiple answers, without at least highlighting or somehow indicating a selected one of the answers, the Lemelson system would be inoperative. Therefore, contrary to the assertion of the Examiner's Answer, in Lemelson the student cannot send back a response that is identical to the question. Appellants' Brief merely explains that point and does not misconstrue Lemelson. The Examiner's position to the contrary, stated at pages 37 and 38 of the Answer is simply incorrect.

At pages 40 and 41 of the Examiner's Answer, it is alleged that the limitation argued with respect to one of the distinctions of claims 68 and 69 from the prior art, namely determining viewer attentiveness if a code input is not identical to a viewing confirmation code but is "within a range" of the viewing confirmation code, is not described in either claim. Therefore, according to the Examiner's Answer, the arguments presented with regard to claims 68 and 69 are unavailing. However, the final paragraph, and particularly the final words, of each of claims 68 and 69 do include the limitation upon which the cited argument is based. Perhaps these limitations were overlooked in preparing the Examiner's Answer.

Finally, the commentary at pages 34-36 of the Examiner's Answer alleging that Von Kohorn is, in fact, analogous prior art, never addresses nor attempts to apply the applicable legal standards of *In re Clay*, 23 USPQ2d 1058 (Fed. Cir. 1992) and *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1991), or other similar opinions cited and explained at MPEP 2141.01(a). As set forth in Appellants' Brief, Von Kohorn is not analogous prior art and its withdrawal as a reference vitiates all prior art rejections on appeal. The opinion cited in the Examiner's Answer in allegedly addressing the non-analogous art argument, *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987), relates to the patentability of claims of a particular mixed form. *Masham* has no relationship to determining whether a publication is analogous prior art.

A prompt and favorable decision on the Appeal is earnestly solicited.

Respectfully submitted,


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JAW:ves